

Serial No.: 10/710,293
Attorney Docket No.: F-822-O1

Patent

REMARKS

1. Status of Claims

Claims 1-17 were pending in the application. Applicants have amended claims 1, 5, 7, 9 and 17 without prejudice or disclaimer. Applicants have added new claims 18-20. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-20 will remain pending in the application.

2. Specification

In section 2 of the Office Action, the Examiner objected to the claim for priority in the specification.

Applicants have amended the specification as suggested and request that the Examiner withdraw the objection.

3. Specification

In section 3 of the Office Action, the Examiner objected to claim 5.

Applicants have amended the claim as suggested and request that the Examiner withdraw the objection.

4. Rejections under 35 USC § 112

In sections 4-6 of the Office Action, the Examiner rejected Claims 1, 7 and 9 under 35 U.S.C. 112 due to alleged insufficient antecedent basis.

In order to expedite prosecution, Applicants have amended the claims to provide antecedent basis and respectfully request that the Examiner withdraw the rejection.

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5. Rejections under 35 USC § 103(a)

In section 7 of the Office Action, the Examiner rejected Claims 1-17 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,119,186 to Watts, et al. ("Watts '186") in view of U.S. Patent Application Publication No. 2004/0061716 A1 by Cheung, et al. ("Cheung '716").

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended the claims 1, 7 and 17 to recite further limitations distinguishing the cited references and accordingly, the rejection is moot.

Applicants respectfully submit that the combination of references is improper. For example, the Examiner states that the reason for the combination is to allow notifications to be viewed and managed by a user as desired in a clear instance if impermissible hindsight. Watts '186 does not teach or suggest a list of notifications or any possibility of delayed response to such notifications. While that problem is appreciated and successfully overcome in the teachings of the present application, it is not a problem appreciated in the art. Accordingly, Applicants respectfully submit that the combination is not proper and request that the Examiner withdraw the rejection.

Additionally, Applicants respectfully dispute the several statements of inherency included in the rejection. To support an "inherency" argument, the Examiner must show that the reference necessarily includes the claimed limitation and not merely that it may. *See In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (rejecting unsupported assertion of inherency).

For example, with regard to the 5 items that the Examiner claims would be inherent in Watts '186 as applied to claim 1, it is not at all inherent that the claimed notification system for defining and storing notifications would be used since Watts '186 does not create a list of notifications for presentation to the user.

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With regard to claims 1 and 17, the cited references do not alone or in proper combination teach or suggest at least:

"defining response descriptions for the needed response instance having needed inputs in an application model;
storing the needed inputs in the response description;"

...

"wherein the notification manager is configured to receive a plurality of new notifications for a user received over time and to receive response to the plurality of the new notifications from the user at the convenience of the user."

With regard to claim 7, the cited references do not alone or in proper combination teach or suggest at least:

"querying the user to allow the user the opportunity to accept or reject the notification from a list including a plurality of notifications received over time."

Furthermore, with respect to claim 7, it is clear that the allegedly inherent teachings are not inherent as they are admitted to be mere possibilities for the reference and thus not inherent material.

Furthermore, even if properly combined, the cited references do not render the presently claimed invention obvious as the mechanism for input primed notifications for delayed activation in a responsive environment.

The respective dependent claims are pentable over the cited references for at least the reasons described above with regard to the respective independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and respectfully submit that claims 1-17 are in condition for allowance.

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Applicants respectfully submit that new claims 18-20 are patentable over the cited references and respectfully submit that claims 1-20 are in condition for allowance.

6. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

7. Authorization

No fee is believed due with this Communication. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-822-O1.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-822-O1.

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Respectfully submitted,



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